

## R E M A R K S

### A. STATUS OF CLAIMS

The Examiner indicates that only Claims 1-7, 11, 12, 14, 15, 26, 27, 32, 33, 59, 60, 62, 63, 74, 75, 80, and 81 are pending. [#4 “Disposition of Claims” in the Office Action Summary; “Notice to Applicant,” page 2]. The Examiner also indicates that only those claims were “elected and presented for examination.” (“Notice to Applicant,” page 2].

However, the Examiner also indicates that Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 were rejected under Section 103(a). [page 2]. Despite this statement, we do not believe that any of Claims 13, 17-25, 30, 31, 35-57, 39-55, 61, 65-73, 78, 79, 83-85, or 87-98 were actually examined or rejected under Section 103(a)—the Examiner does not mention any one of the claims specifically. The Examiner only addresses the limitations of the claims that the Examiner indicated was pending in the “Notice to Applicants”.

We respectfully request clarification of the status of all claims in this application, as we disagree with what the Examiner believes are the pending claims and what claims the Examiner believes should have been examined. We also respectfully request that the Examiner examine claims that are pending but have not yet been examined, and to provide a new non-final Office Action for the as-yet unexamined claims. The following is our understanding of the status of every claim ever filed in the application and the corresponding Amendment(s) or Office Action:

- Claims 1-98 are pending [Amendments mailed April 14, 2005; December 22, 2004; July 21, 2004; Office Action mailed October 22, 2004; each paper indicates all of Claims 1-98 are pending]
- Claims 99-110 are cancelled [Amendment mailed July 21, 2004]
- Claims 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86 are withdrawn from examination (but not cancelled) [Amendment mailed April 14, 2005]
- Claims 1, 13, 25, 49, 61 and 73 are generic [Office Action mailed October 22, 2004 (Paper No. 10152004)]
- All pending and non-withdrawn claims (Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98) should be examined [See Amendment mailed April 14, 2005, page 17]

- Claims 13, 17-25, 30, 31, 35-57, 39-55, 61, 65-73, 78, 79, 83-85, and 87-98 should have been but were not examined in the present Office Action

We encourage the Examiner to contact the undersigned so that the status of the claims can be clarified.

#### B. SECTION 101 REJECTIONS

All of Claims 1-7, 11, 12, 14, 15, 26, 27, 32, 33, 59, 60, 62, 63, 74, 75, 80, and 81 stand rejected under Section 101 for failing to “utilize any technological device in performing the various claimed steps” or failing to “recite any application or use of the technological arts.”

There is no “technological arts” test requiring “technological device” or “use of the technological arts.” Please see the Board’s precedential decision in Ex Parte Lundgren (BPAI 2005) (explicitly finding that there is no legal basis for any “technological arts” test).

We are grateful that the Examiner has determined and explicitly made of record that Claim 1 (and all of its dependent claims) produces a useful, concrete, and tangible result. We submit that all of the pending claims produce a useful, concrete, and tangible result; the Examiner does not disagree.

As every claim produces a useful, concrete, and tangible result and the “technological arts” test used by the Examiner is invalid in light of Ex parte Lundgren, we submit that all of the pending claims are directed to statutory subject matter. We respectfully request withdrawal of the Section 101 rejections.

#### C. SECTION 103(A) REJECTIONS

Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 stand rejected under Section 103(a) based on assessments of the prior art the Examiner indicates are supported by Buhler (U.S. Patent No. 6,077,193) and Brown (U.S. Patent No. 6,210,272). We respectfully submit that the Examiner has not made a prima facie case of obviousness for any pending claim.

#### 1. Claims 13, 17-25, 30, 31, 35-57, 39-55, 61, 65-73, 78, 79, 83-85, and 87-98 were not examined

As discussed above, although the Examiner lists all of Claims 13, 17-25, 30, 31, 35-57, 39-55, 61, 65-73, 78, 79, 83-85, and 87-98 in the introductory paragraph for the Section 103(a) rejections, none of those claims is actually addressed in the Office Action. In contrast, each of the other pending claims is addressed in its own respective paragraph. It appears that the Examiner inadvertently forgot to address these claims. We respectfully submit that no prima facie case of obviousness has

ever been made for any of Claims 13, 17-25, 30, 31, 35-57, 39-55, 61, 65-73, 78, 79, 83-85, or 87-98. We respectfully request the Examiner provide a new Office Action addressing these claims.

We respectfully submit that all of the unexamined claims are allowable over the cited references. Claims 13, 17-25, 30, 31, and 35-48 are allowable for at least the same reasons as stated above with respect to independent Claim 1. Each of these dependent claims also includes additional limitation(s) that have not been addressed by the Examiner for obviousness. We respectfully note that even where an unexamined claim is “generic” (such as Claim 13, according to the Examiner), that does not waive the requirement to show that a “generic” limitation would have been obvious to provide for even if a particular “species” (e.g., Claim 14) of that genus would have been obvious.

#### **1.01. Independent Claims 49 and 97 were not examined**

Claims 49 and 97 are independent and are allowable at least because no combination of the cited references suggests receiving an indication that a preventative treatment to be adopted by a customer involved in a transaction has been adopted by that customer, and providing a benefit for the transaction. All of Claims 50-55, 61, 65-73, 78, 79, 83-85, and 87-93 depend from independent Claim 49 and are allowable for at least the same reasons. Claims 94-96 are independent and are allowable for at least the same reasons as Claim 49. Claim 98 depends from Claim 97 and is allowable for at least the same reasons as Claim 97.

#### **1.02. Some examples of additional limitations of unexamined claims not suggested by the references**

Further, we submit that none of the following limitations of unexamined claims are taught or suggested by the cited references:

- Claims 21 and 69: *a probability that a customer will remain insured by the insurer for a predetermined time*
- Claims 22-25 and 70-73: *receiving a security for the benefit from the customer*
- Claims 25 and 73: *wherein the security is used to reimburse the payment of the benefit when a predetermined condition is not met*
- Claims 30 and 78: *assigning a treatment provider for the selected preventative treatment*
- Claims 31 and 79: *wherein the benefit comprises at least one of: a currency amount, an alternate currency amount, a percentage discount on a purchase, and a reduced insurance premium*

- Claims 35 and 83: *determining the benefit based on an expected future cost*
- Claims 36 and 84: *determining a present value of a future cost and determining the benefit based on the present value*
- Claim 52: *wherein said transaction comprises at least one of: a purchase of a product, a purchase of a service, an insurance premium, and an online purchase*
- Claim 98: *wherein a value for the benefit is determined from an expected future cost corresponding to the preventative treatment*

## 2. Independent Claim 1

The Examiner has not established a prima facie case of obviousness for independent Claim 1. Claim 1 includes the following feature:

- *receiving an identification of a customer involved in a transaction with a third party*

The Examiner asserts this feature was known in the prior art and relies on Column 1, lines 15-23 of Buhler as supporting evidence. The cited portion of Buhler, however, cannot support the Examiner's assertion that such a feature was known. The evidence relied upon is:

Although the advantages of a regular exercise program are widely publicized, the actual number of individuals engaged in such a program both in the U.S. and throughout the world is much less than the total population who would benefit from such a program. Reasons for this are many, but one common reason is that the user is personally uncomfortable about getting started in an exercise program or, even once started, the user drops out of an exercise program due to the lack of any personal incentive program.

The Examiner unfortunately did not explain how the cited portion was being interpreted as teaching the above feature. We respectfully request the Examiner clarify how the cited passage teaches the claimed feature so that we may better assist the Examiner with examination.

We respectfully submit that this cited portion does not suggest receiving an identification of a customer (or receiving anything). It also does not appear to suggest a customer involved in a transaction with a third party, or receiving an identification of such a customer.

Because the evidence relied upon by the Examiner does not support the Examiner's assertion that the above feature was known, the Examiner has not established a *prima facie* case of obviousness.

Further, we have considered the rest of the Buhler reference and the Brown reference, and they do not appear to suggest that the above feature was known. If the Examiner intended to rely on a different portion of the cited references (or on another reference) for the claimed feature, we respectfully request that the Examiner identify the evidence of record relied upon and provide the Examiner's reasoning as to how such evidence would support a finding of obviousness.

Claim 1 also recites the following features:

- *determining a preventative treatment for the customer*
- *offering a benefit to the customer for the transaction if the customer adopts the preventative treatment*

The Examiner acknowledges that Buhler does not disclose these features. The Examiner asserts:

However, this feature is known in the art, as evidenced by Brown. In particular, Brown teaches determining a preventative treatment for the customer (See Brown, Col. 7, lines 24-67 to Col. 8, line 16); and offering a benefit to the customer for the transaction (if the customer adopts the preventative treatment (See Brown, Col. 7, lines 24-67 to Col. 8, line 16).

We respectfully disagree. Brown does not appear to have anything to do with the above claimed features. Although the described game play in Brown may involve simulated treatments for game characters, body regions, or other "game constructs," it does not even hint at *transactions* or *treatment for a customer*. Unfortunately, we do not understand how the Examiner is interpreting the cited portion, and we respectfully request clarification.

For example, we would greatly appreciate an explanation of how Brown teaches a benefit to the customer for a transaction. Brown does not appear even to suggest a transaction, a benefit to a transaction, or offering such a benefit for adopting a preventative treatment. The cited portion describes in part:

Correlating the players, progress can be achieved through the use of common resources by the players, or through the use of a scoring system based on the Prisoner's Dilemma, among other methods. A score is merely a convenient example of a reward; other rewards can be used instead or in combination with a score in a method of the present invention.

[Column 8, lines 1-7]. It is possible that the Examiner is asserting that a “score” or “reward” teaches the claimed feature of a benefit, but the Examiner does not clearly indicate this. If that is what the Examiner intended to convey, we respectfully request that the Examiner state so for the record. We also respectfully note that even if the described “score” or a “reward” generally suggests a benefit, it does not even remotely suggest *a benefit to a customer for a transaction with a third party* (or *offering* such), as generally recited in Claim 1. If the Examiner disagrees, we respectfully request that the Examiner clarify the record with an explanation of how the cited portion of Brown teaches the offering of a benefit for a transaction.

Further, we would greatly appreciate an explanation of how Brown teaches (in the cited portion or otherwise) *determining a preventative treatment for a customer* (or offering a benefit *if the customer adopts the preventative treatment*), as generally recited in Claim 1. Although Brown describes a game in which game play may simulate the treatment of an illness or condition, nothing in Brown suggests determining a preventative treatment for a customer. Brown does not suggest that either the game constructs in the game or the users of the game system are *customers involved in a transaction*, and thus cannot suggest *determining a preventative treatment for such a customer*, as generally recited in Claim 1. Again, if the Examiner disagrees, we respectfully request the Examiner clarify how the cited portion (or any other portion of the Brown video game system) would suggest that these features were known.

The cited portion otherwise explains: how the video game system described in Brown can use different implementations of a Prisoner’s Dilemma game [Column 7, lines 24-37]; how in each embodiment of the Brown game system, “game players are constantly aware of the other player’s actions and the current status of common resources” and how “sharing and cooperation between players are inherent to success” [Column 7, lines 38-46]; “an internet-connected approach” and a “direct-connection approach” for the game system [Column 7, lines 46-63]; and use of the game system for health education [Column 8, lines 7-14]. We do not believe that any of these descriptions have anything to do with the claimed features. If the Examiner disagrees, we respectfully request that the Examiner clarify the Examiner’s interpretation of Brown.

We also do not agree with the Examiner’s determination that it would have been obvious to combine the Brown and Buhler systems. We do not understand how the Examiner has proposed that the Buhler system would be modified to incorporate the multiplayer gaming system of Brown. We do not agree that it would be obvious for someone working out in a physical fitness program (as described in Buhler) to be involved in a “multiplayer interactive electronic game

for health education” in which a player “manages the health of a game construct such as a game character or body region” (as described in Brown). Regardless, even if a motivation were known in the prior art (which we dispute) the proposed combination would not provide for all of the specific features of Claim 1, for the reasons outlined above. For example, no combination of any subject matter described in Brown and Buhler would provide for *offering a benefit to a customer for a transaction (with a third party) if that customer adopts a preventative treatment determined for that customer*, as generally recited in Claim 1.

Thus, based on our understanding of the Examiner’s position, we respectfully submit that we disagree with the Examiner’s findings that Brown and Buhler support the obviousness rejection of Claim 1. We do not agree that the cited references are substantial evidence of the Examiner’s assessment of the prior art, but we request that the Examiner clarify his position (e.g., by explaining how the cited portions teach particular claim limitations) so that we may better assist the Examiner with examination of the pending claims. We respectfully submit that the Examiner has not established a prima facie case of obviousness of Claim 1 (or any of its dependent Claims 2-7, 11-15, 17-27, 30-33, 35-37, and 39-45) and request the withdrawal of the Section 103(a) rejection of those claims.

### 3. Claim 4

The Examiner asserts:

Buhler discloses the method wherein said customer is involved in a transaction comprising at least one of: a purchase of a product, a purchase of a service, an insurance premium, and an online purchase (See Buhler, Col. 2, lines 30-39).

[page 5]. We do not agree. The cited portion includes brief descriptions of Figures 2-B, 3, and 4. Nothing in the descriptions suggests any type of purchase or an insurance premium. Brown does not suggest the claimed feature; the Examiner does not assert otherwise. Even if Buhler teaches what is asserted (which we dispute), no combination of the cited references teaches or suggests offering a benefit to a customer for any of the recited types of transactions if the customer adopts a preventative treatment for the customer, as recited in Claim 4 (through incorporation of limitations from Claim 1). We respectfully submit that no prima facie case of obviousness has been made for Claim 4 and request that the Examiner withdraw the Section 103(a) rejection.

### 4. Claims 6 and 7

The Examiner asserts that Brown discloses the claimed features of Claims 6 and 7. We do not agree. However, even if Brown was evidence that such features were known, no combination of the cited references teaches or suggests offering a

benefit to a customer for a transaction (with a third party) if the customer adopts any of the specified types of preventative treatments for the customer. We respectfully submit that no prima facie case of obviousness has been made for Claims 6 and 7 and request that the Examiner withdraw the Section 103(a) rejections.

## 5. Claims 11 and 59

The Examiner asserts that Brown discloses *comparing a cost associated with each of said preventative treatments*, as generally recited in each of Claims 11 and 59. We respectfully disagree. The cited portion does not appear to suggest anything remotely related to costs associated with treatment (or future cost, as in Claim 59), much less comparing of such costs.

The Examiner also asserts that Brown discloses *selecting at least one of said plurality of preventative treatments based on said comparing*, as recited in each of Claims 11 and 59. We respectfully disagree. First, the cited portion has nothing to do with the portion cited as teaching comparing of costs (Column 1, lines 15-61). Second, the cited portion does not remotely suggest selecting a preventative treatment based on cost, much less based on comparing costs of a plurality of treatments.

We respectfully request that the Examiner please clarify his reasoning with respect to the cited portions of Brown and to indicate what specific description in each cited portion led the Examiner to find that the claimed features were known in the prior art. The record does not include any such reasoning and we are unclear as to why the Examiner has relied on the cited evidence, as it does not appear to have anything to do with the claimed subject matter. We respectfully submit that no prima facie case of obviousness has been made for Claims 11 and 59. Also, as the Examiner has failed to address independent Claim 49, from which Claim 59 ultimately depends, the Examiner has not established a prima facie case of obviousness for Claim 59.

We respectfully request that the Examiner withdraw the Section 103(a) rejections of Claims 11 and 59.

## 6. Claims 12 and 60

Claim 12 depends from Claim 11. Claim 60 depends from Claim 59. In addition to the reasons stated with respect to Claim 11 and 59, we respectfully submit that contrary to the Examiner's assertion, Buhler does not teach or suggest *in which selecting at least one of a plurality of preventative treatments based on comparing a cost associated with each of the plurality of preventative treatments comprises selecting a preventative treatment having a lowest cost*, at Column 1,

lines 54-57, or otherwise in Buhler. Regrettably, we do not know why the Examiner has cited this particular portion of Buhler for this subject matter, as it does not suggest anything to do with selecting a preventative treatment having a lowest cost. The cited portion mentions that the “low cost” of the described “data collector” of Buhler means it can be installed “for any conceivable exercise program or exercise device.” It does not suggest selecting the “data collector” as a preventative treatment from a plurality of preventative treatments. We respectfully submit that no *prima facie* case of obviousness has been made for Claims 12 and 60. Also, as the Examiner has failed to address independent Claim 49, from which Claim 60 ultimately depends, the Examiner has not established a *prima facie* case of obviousness for Claim 60.

We respectfully request that the Examiner withdraw the Section 103(a) rejections of Claims 12 and 60.

## 7. Claims 14 and 15

Some embodiments of the present invention provide for determining a future cost of a condition based on a probability of a customer contracting that condition. [See, e.g., Specification, page 8, lines 1-5; page 17, line 17 to page 18, line 2; page 19, lines 1-2; page 24, line 20 to page 25, line 3].

Claim 14 recites a feature of

- *determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition*

Claim 15 recites a feature of

- *determining a future cost for the at least one condition, wherein the future cost is determined based on a probability of the customer contracting the condition within a predetermined time*

The Examiner asserts that Buhler discloses these features at Column 1, lines 25-61 and Column 4, lines 56-67 to Column 5, line 7. We respectfully disagree. Nothing in the cited portions remotely hints at

- (i) a customer contracting a condition,
- (ii) a probability of a customer contracting a condition, or
- (iii) determining a future cost for the at least one condition based on the probability of contracting the condition.

We respectfully request that the Examiner please clarify his reasoning with respect to the cited portion of Buhler and to indicate what specific description led

the Examiner to find that the claimed features were known in the prior art. For example, we would be grateful if the Examiner would explain how Buhler is being interpreted as suggesting a probability of contracting a condition, and a future cost of a condition being determined based on such a probability. The record does not include any such reasoning and we are unclear as to why the Examiner has relied on the cited evidence. We respectfully submit that no *prima facie* case of obviousness has been made for Claims 14 and 15 and request that the Examiner withdraw the Section 103(a) rejections.

## 8. Claims 62 and 63

Each of Claims 62 and 63 depends from Claim 59 and they are believed to be allowable for at least the reasons stated above with respect to Claim 59.

Claim 62 recites a feature of

- *wherein the future cost [associated with each of said plurality of preventative treatments] is determined based on a probability of the customer contracting the condition*

Claim 63 recites a feature of

- *wherein the future cost [associated with each of said plurality of preventative treatments] is determined based on a probability of the customer contracting the condition within a predetermined time*
- *contracting the condition within a predetermined time*

The Examiner asserts that Brown discloses the feature of Claim 62 at Column 7, lines 16-31. The Examiner asserts that Buhler discloses the feature of Claim 63 at Column 4, lines 56-67 to Column 5, line 7. We respectfully disagree. Nothing in the cited portions (or otherwise in either reference) remotely hints at

- (i) a customer contracting a condition,
- (ii) a probability of a customer contracting a condition,
- (iii) determining a future cost associated with each of a plurality of preventative treatments based on the probability of contracting the condition,
- (iv) comparing future costs as determined in (iii), or
- (v) selecting at least one preventative treatment based on comparing as in (iv);

as generally provided for in each of Claims 62 and 63.

We respectfully request that the Examiner please clarify his reasoning with respect to the cited portions of Brown and Buhler and to indicate what specific

description led the Examiner to find that the claimed features were known in the prior art. For example, we would be grateful if the Examiner would explain how Brown (in particular the cited discussion of the Prisoner's Dilemma) and Buhler are being interpreted as suggesting a probability of contracting a condition, and a future cost of preventative treatment being determined based on such a probability. The record does not include any such reasoning and we are unclear as to why the Examiner has relied on the cited evidence. We respectfully submit that no prima facie case of obviousness has been made for Claims 62 and 63 and request that the Examiner withdraw the Section 103(a) rejections.

Also, as the Examiner has failed to address independent Claim 49, from which Claims 62 and 63 ultimately depend, the Examiner has not established a prima facie case of obviousness for Claims 62 and 63.

#### **9. Claims 26, 27, 74, and 75**

Each of Claims 26 and 27 depends from Claims 22 and Claim 25. Each of Claims 74 and 75 depends from Claims 70 and 73. The Examiner has never addressed the limitations of Claims 22, 25, 70, or 73. Accordingly, we respectfully submit that the Examiner has failed to establish a prima facie case of obviousness of Claims 26, 27, 74, or 75. The cited references to not teach the limitations recited in Claims 22, 25, 70, or 73. Specifically, there is no hint of *receiving a security for the benefit from the customer* (Claims 22, 70) or *wherein the security is used to reimburse the payment of the benefit when a predetermined condition is not met* (Claim 25, 73). Also, as the Examiner has failed to address independent Claim 49, from which Claims 74 and 75 ultimately depend, the Examiner has not established a prima facie case of obviousness for Claims 74 and 75.

We respectfully request the withdrawal of the Section 103(a) rejection of Claims 26, 27, 74, and 75.

#### **10. Claims 59, 60, 62, 63, 74, 75, 80, and 81—Rejections are Flawed**

Claims 59, 60, 62, 63, 74, 75, 80, and 81 depend from Claim 49, which the Examiner has not actually examined. Accordingly, the Examiner has failed to establish a prima facie case of obviousness for any of Claims 59, 60, 62, 63, 74, 75, 80, and 81. Although the Examiner addresses each of these claims with a corresponding paragraph in the Office Action, none of the limitations of independent Claim 49 are addressed. We respectfully request the withdrawal of the Section 103(a) rejections of Claims 59, 60, 62, 63, 74, 75, 80, and 81 and request the Examiner address all of the limitations of each pending claim in a new non-final Office Action.

**D. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not specifically addressed here, including assertions of what Buhler and Brown teach or suggest, or asserted interpretations of claimed subject matter, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable *prima facie* case of obviousness for any of the pending claims, for at least the reasons stated in this paper, we need not address the Examiner's other assertions at this time.

**E. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

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